



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,880	05/01/2001	Robert Harada	3013/21	5913

7590

11/04/2005

John G. Bisbikis
McDermon, Will & Emery
227 W. Monroe Street
Chicago,, IL 60606-5096

EXAMINER

DASS, HARISH T

ART UNIT

PAPER NUMBER

3628

DATE MAILED: 11/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/846,880	HARADA ET AL.	
	Examiner	Art Unit	
	Harish T. Dass	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cotton et al (hereinafter Cotton - US 6,076,074) in view of Riboud (US 6,269,345) and Komem et al (hereinafter Komem – US 6,892,184).

Re. Claim 1, Cotton discloses creating a payment instruction and a payment request that are associated with a common transaction request [Cotton– see entire document particularly, Abstract; Figures 2-3; C4 L23 to C5 L67]; communicating the payment request to a funds source associated with the source account; wherein: in accordance with the payment request, funds are transferred from the source account to a treasury (FRB2) account if necessary to maintain a balance at the treasury account which is sufficient to cover an amount of the payment request, and funds at the treasury account are used to provide at least one of (a) a payment to [Cotton – C1 L48-L64; C2 L50 to C3 L15; C3 L65-67; C15 L12-L45; C16 L12-L39]. Cotton does not explicitly disclose communicating the payment instruction directly to the local currency account in the second country; and wherein the payment instruction designates a

Art Unit: 3628

beneficiary account in the second country for the local currency account to transfer currency to, and a credit entry on behalf of, the local currency account in a currency of the second country, separately communicating payment request. However Riboud discloses these steps [C1 L52 to C2 L45; C6 L35-L57; C7 L38-L53] to provide a transfer system that can be used to regulate monetary flows in international transactions, this system enabling the transfer of quantities, measured in different local units of measurement, between a plurality of entities. Additionally, Komem discloses communicating payment instruction directly and separately communicating payment request [abstract; Figure 1-2; C2 L18-L21; C3 L51-L61; C7 L1-L28; C9 L31-L38] to provide e-commerce transactions in multiple currency in which the local currency of the buyer (sender) is different from the local currency of the vendor (receiver) and monitor the foreign currency position in each currencies for settlement. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Cotton and include communicating the payment instruction to the local currency account in the second country; and wherein the payment instruction designates a beneficiary account in the second country for the local currency account to transfer currency to, and a credit entry on behalf of, the local currency account in a currency of the second country, as disclosed by Riboud and Komem, to provide a settlement system that sends a payment message to another participant incurs an obligation to pay the receiving participant the amount of the transfer and monitor the foreign currency position in each currencies for settlement.

Re. Claims 2-3, Cotton discloses wherein: the payment to the local currency account is provided by exchanging the funds at the treasury account for the currency of the second country, and transferring the exchanged funds to the local currency account, and wherein: the credit entry is provided by exchanging the funds at the treasury account for the currency of the second country, and making a credit entry for the exchanged funds in a general ledger on behalf of the local currency account [C16 L22-L67].

Re. Claim 4, Cotton discloses the communicating of the payment instruction to the local currency account is independent of the communicating of the payment request to the funds source [C1 L65 to C2 L15].

Re. Claim 5, Cotton discloses wherein: the funds source draws from the source account [C5 L48-L55].

Re. Claim 6, Cotton discloses wherein: the payment instruction identifies at least one of: a currency type of the first country, the source account, and a type of financial product associated with the transaction request [C1 L64 to C2 L30; C16 L12-L23].

Re. Claim 7, Cotton discloses wherein: the payment instruction and the payment request are created via user inputs to a computer-generated interface [C2 L3-L5].

Re. Claim 8, Cotton discloses validating transaction data associated with the payment instruction prior to communicating the payment instruction to the local currency account [C2 29-L50].

Re. Claims 9-11, Cotton discloses where in: the user is enabled to create the transaction request using a computer system [C2 L4-L5]. Riboud further discloses further comprising: determining an exchange rate to offer to a user that creates the transaction request for approval thereby prior to communicating the payment instruction to the local currency account, wherein the providing of the payment to, or credit entry on behalf of, the local currency account, is responsive to the exchange rate, the exchange rate is determined using data that is stored locally to the computer system, and wherein: the user is enabled to create the transaction request using a computer system; and the exchange rate is dynamically determined through an external foreign exchange information service [Figures 3, 5; C1 L64 to C2 L9; C7 L60-L67; C5 L53-L65; C6 L65 to C11; C8 L48 to C9 L11] to determine the conversion operation to convert local unit (local currency) to second entity (foreign currency) and transfer the amount in different currency. Further, currency exchange is well known for example, American Express office around the US and overseas daily publish foreign exchange rate of major foreign currency for travelers to provide user with information what is the conversion rate, similarly major newspapers publish the currency exchange rate for different currency. It would have been obvious to one

Art Unit: 3628

of ordinary skill in the art at the time the Applicant's invention was made to combine disclosures Cotton, Komem and Riboud to provide foreign currency conversion rate and means to transfer currency at market rate.

Re. Claim 12, Cotton discloses further comprising: querying the funds source to determine if there are sufficient funds thereat to fund the payment request [C2 L29-L41].

Re. Claim 13, Cotton discloses further comprising: debiting the source account according to the amount of the payment request [C7 L41-L46].

Re. Claim 15, Cotton discloses wherein: the currency of the local currency account is transferred therefrom to the beneficiary account via at least one intermediary financial institution in the second country [C1 L48-L54].

Re. Claims 14 and 16, Cotton, Riboud Komem does not explicitly disclose wherein: the currency of the local currency account is transferred directly therefrom to the beneficiary account without passing through an intermediary financial institution, and wherein: the local currency account comprises a Nostro account. However, Nostro accounts (Correspondent account) are well known where account is a demand deposit account or a current account, deposited by a local bank with the foreign bank in the currency of the country where the money is held. It would have been obvious to one of ordinary skill in the art at the time

Art Unit: 3628

the Applicant's invention was made to modify disclosures Cotton, Komem and Riboud and include Nostro accounts in order to make payments in the local currency via the local payment system without intermediary.

Re. Claims 17 and 18, Cotton discloses wherein: the payment is provided to the local currency account in lieu of providing the credit entry on behalf of the local currency account according to the amount of the payment request [C8 L60 to C9 L15] and wherein: the payment is provided to the local currency account in lieu of providing the credit entry on behalf of the local currency account according to a risk profile associated with the payment request [C8 L47-L59].

Re. Claim 19, Cotton discloses wherein: the funds from the funds source are transferred to the treasury account via a clearing account [C3 L25-L76; C1 L37-L48].

Re. Claim 20, Cotton discloses wherein: the payment instruction is communicated to the local currency account in the second country via a financial interchange network [C5 L30-L46].

Re. Claim 21, Cotton further comprising: enabling tracking (convey information) of the transaction request by a user (operator) [C2 L7-L14; C21 L48-L67].

Art Unit: 3628

Re. Claims 22, Cotton, Komem or Riboud does not explicitly disclose, wherein: enabling a user to create the transaction request using a browser-compatible interface running on a computer system. However, browsers such as Netscape and Explorer are well known where user can utilize either one of them to log to a financial institution website and transfer money, check account, etc. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to modify disclosures Cotton, Komem and Riboud and include user interface which uses compatible browser that will allow the user to use any type of personal computer, work station or operating system for doing business without relying on expensive specialized software.

Re. Claims 23-24, limitations of claims 23 and 24 are substantially similar to claim 1, therefore claims 23 and 24 are rejected with same rational as claim 1.

Claims 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Riboud in view of Jennings et al (hereinafter Jennings – US 5,659,165).

Re. Claim 25, Riboud discloses information from a user for identifying the user and for identifying at least one account from which funds may be drawn when an international payment transaction is executed, creating a record having the information for identifying the user and for identifying the at least one account [C6 L35-L57; C7 L38-L66]. Riboud does not explicitly disclose assigning an identifier for the record to retrieving the record in order to customize the computerized user

Art Unit: 3628

interface to enable the user to make an international payment transaction upon a subsequent access of the system by the user, and during an initialization access session of an international payment transaction system by a user, receiving, via a computerized user interface. However, Jennings discloses these steps [Abstract; Figures 4 (#72), 6, C1 L62 to C2 L29; C2 L6 L33-L62; C6 L32-L63; C8 L28-L52 – see identify any customer accounts associated with the card and once identification, validation have been accomplished ..., and international application] to provide interactive display screen and data input function. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Riboud and include user interface to enter his/her information (card) and PIN, as disclosed by Jennings, to access the system and initiate transferring foreign exchange.

Re. Claim 26, Jennings further discloses wherein: the customized computerized user interface enables the user to make an international payment transaction without having to re-enter the information for identifying the at least one account, and communicating with an institution at which the account is held to verify the at least one account [C1 L40-L62; C2 L30-L50; C6 L32-L63; C8 L28-L37] to initiate transaction without entering account number. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Riboud and include user interface enabling the user to initiate transaction without entering customer number, as disclosed by Jennings, to use his/her card for transaction without inputting manually account information.

Art Unit: 3628

Re. Claim 28, neither Riboud nor Jennings discloses further comprising: communicating with a credit-reporting bureau to obtain an indication of a credit worthiness of the user. However this step is well known, for example, if customer does not have enough deposit in his/her account or special arrangement with his/her financial institution (such as over draft) the transaction can not go through or his/her credit card does not have adequate limit to cover the transaction, the transaction is denied. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Riboud and Jennings and include communicating with a credit-reporting bureau to obtain an indication of a credit worthiness of the user to protect the financial institution form loss and fraud.

Response to Arguments

1. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3628

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CFR ' 1.111 (c) to consider the references fully when responding to this action.

US 6,938,013 to Gutierrez-Sheris "Money-Transfer Techniques" discloses method of transferring money from a customer to a beneficiary that advantageously overcomes the deficiencies of conventional money transfer technologies known in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T. Dass whose telephone number is 571-272-6793. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 571-272-6799. The


Art Unit: 3628

fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Harish T Dass
Examiner
Art Unit 3628

HTD
10/28/05


HYUNG SONG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600